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09/658,389	09/08/2000	Lorenzo H. Thomson	57008	3440

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EXAMINER

KIM, CHONG HWA

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,389

Applicant(s)

THOMSON ET AL.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,14,16,23,32 and 39-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12,13,15,17-22,24-31 and 33-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The Examiner acknowledges the applicant's Amendment filed Jun 10, 2002 in response to the Office action made on May 2, 2002.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 8, 9, 19, 28, and 33-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 8, 19, 28, and 33 recite the limitation wherein the fastener receiving passageway in each clamp member is canted at a predetermined angle from a line parallel to an axis of the imaginary cylinder. Also, the specification, as originally filed, describes the way in which the clamps are drawn together by the fastener so that the clamps might (in a way) rotate relative to one another so that the clamps, with the proximal contacting surfaces to each other, engage (or touch) the steering tube. However, the specification does not provide adequately or describe in such a clear and concise way as to how the clamp is moved (or rotated transversely to the axis 49) in a confined and tight clamp receiving passageway 36 as shown in Figs. 2 and 13. It appears that the clamp receiving passageway 36 must be provided with a space wherein the clamp 40 can rotate transversely or reshape the clamp receiving

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passageway 36 so that the passageway can accommodate the "canting" of the clamp 40 in order for such "urging" of the clamps to work properly. In such a tight and confined passageway 36, the fastener 46 may be inserted into the first fastener receiving passageway 42b, but it would be almost impossible to engage the second fastener receiving passageway 42c without breaking the passageway 36 or the clamp members 40 (see Fig. 14A).

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 10, 12, 13, 15, 17, and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/658,509 in view of Lai, U.S. Patent 5,509,328.

The copending Application No. 09/658,509 recites the limitations of the bicycle stem comprising the body portion, the handlebar clamping portion, the handlebar clamping member, the steering tube clamping portion, and the steering tube clamp, wherein the body portion, the handlebar clamping portion, and the steering tube clamping portion are integrally formed as a monolithic unit, the fasteners for securing the handlebar clamping member having a recess and

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generally a rectangular shape to the handlebar clamping portion having a recess and generally a rectangular shape, the body portion being a tubular shape with a hollow interior, and a steering tube clamp in the clamp receiving passageway and comprising a pair of cooperating clamp members aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder and a recess therein for the steering tube extending for greater than a predetermined angle, but fails to recite each clamp member having at least one fastener receiving passageway for receiving at least one fastener for urging the clamp members together to engage the steering tube, the pair of clamp member each having a same shape and an end having a circular shape.

Lai shows, in Figs. 6 and 8, a bicycle stem comprising a steering tube clamping portion 70 having a tubular shape 71 defining a steering tube receiving passageway therethrough, and wherein the steering tube clamping portion 70 has a clamp receiving passageway 74 therein transverse to the steering tube receiving passageway 71 and in communication therewith; and further comprising a steering tube clamp 81, 82 in the clamp receiving passageway 74 and comprising a pair of cooperating clamp members 81, 82, each having a same shape and an end having a circular shape, aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder and a recess 87, 88 therein for the steering tube 6, each clamp member 81, 82 having at least one fastener receiving passageway 86, 85 therein offset a predetermined distance from an axis defined by the imaginary cylinder (the imaginary cylinder is taken as one that is disposed within the clamp receiving passageway 74, not coaxially aligned with the passageway 74, and at a proximal location from the steering tube 6), and at least one fastener 84 extending between corresponding fastener receiving passageways 86, 85 of the pair

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of clamp members 81, 82 for urging the clamp members together to engage the steering tube 6 and thereby secure the bicycle stem to the steering tube 6.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the clamping device of the copending Application No. 09/658,509 with the pair clamp device of Lai in order to provide a tighter and more versatile clamping device so that the operation of the bicycle is not compromised.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 10, 12, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lai, U.S. Patent 5,509,328.

Lai shows, in Figs. 6 and 8, a bicycle stem 20, 70 for connecting a bicycle handlebar to a bicycle steering tube 6, the bicycle stem comprising;

a body portion 20 having opposing first and second ends 30, 40;

a handlebar clamping portion 31 connected to the first end of the body portion 30;

a steering tube clamping portion 70 connected to the second end 40 of the body portion

and having a tubular shape 71 defining a steering tube receiving passageway 71 therethrough, the

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steering tube clamping portion 70 also having a clamp receiving passageway 74 therein transverse to the steering tube receiving passageway 71 and in communication therewith;

a steering tube clamp 81, 82 in the clamp receiving passageway 74 and comprising a pair of cooperating clamp members 81, 82 aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder (the imaginary cylinder is taken as one that is disposed within the clamp receiving passageway 74, not coaxially aligned with the passageway 74, and at a proximal location from the steering tube 6) and a recess 87, 88 therein for the steering tube 6, each clamp member 81, 82 also having at least one fastener receiving passageway 85, 86 therein offset a predetermined distance from an axis defined by the imaginary cylinder, and at least one fastener 84 extending between corresponding fastener receiving passageways 85, 86 of the pair of clamp members 81, 82 for urging the clamp members 81, 82 together to engage the steering tube 6 and thereby secure the bicycle stem to the steering tube;

wherein the fastener receiving passageway 85, 86 are offset the predetermined distance from the axis of the imaginary cylinder in a direction away from the recess;

wherein the recess 87, 88 for the steering tube 6 extends for greater than a predetermined angle;

wherein the pair of clamp members 81, 82 have a same shape;

wherein each clamp member 81, 82 comprises an end having a circular shape; and

further comprising a handlebar clamping member 32 cooperating with the handlebar clamping portion 31 to clamp the bicycle handlebar therebetween.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Roddy, U.S. Patent 5,881,606

Lai shows, as discussed above in the rejection of claim 1, the bicycle stem comprising the body portion, the handlebar clamping portion, and the steering tube clamping portion, but fails to show the body portion, the handlebar clamping portion, and the steering tube clamping portion being integrally formed as a monolithic unit.

Roddy shows, in Figs. 2 and 4, a bicycle stem comprising a body portion 10, a handlebar clamping portion 13 and a steering tube clamping portion 14 being integrally formed as a monolithic unit.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the multiple parts of Lai with the monolithic unit as taught by Roddy in order to provide a simpler method of making so that cost of making and installing is reduced.

8. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Roddy.



Lai shows, as discussed above in the rejection of claim 1, the bicycle stem comprising the steering tube clamping portion having a steering tube clamp with at least one fastener wherein the fastener 84 is a bolt having an enlarged head and a threaded shaft extending outwardly therefrom, but fails to show a first fastener and a second fastener, but extending in opposite directions from each other.

Roddy shows, in Figs. 2 and 4, a bicycle stem 10 comprising a body portion having a steering tube clamping portion 14, wherein the clamping portion 14 comprises a steering tube clamp 17, 18 aligned as a pair of cooperating clamp members in side-by-side relation and wherein a first bolt 21 and a second bolt 21 extend in opposite direction for urging the clamp members together to engage the steering tube 12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the single fastener of Lai with the plurality of fasteners extending in opposite direction as taught by Roddy in order to provide a tighter and more securing clamping device so that the operating the vehicle is safer.

9. Claims 17, 18, 20-22, 24-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Roddy, U.S. Patent 5,881,606.

Lai shows, in Figs. 6 and 8, a bicycle stem 20, 70 for connecting a bicycle handlebar to a bicycle steering tube 6, the bicycle stem comprising;

a body portion 20 having opposing first and second ends 30, 40;

a handlebar clamping portion 31 connected to the first end of the body portion 30;

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a steering tube clamping portion 70 connected to the second end 40 of the body portion and having a tubular shape 71 defining a steering tube receiving passageway 71 therethrough, the steering tube clamping portion 70 also having a clamp receiving passageway 74 therein transverse to the steering tube receiving passageway 71 and in communication therewith;

a steering tube clamp 81, 82 in the clamp receiving passageway 74 and comprising a pair of cooperating clamp members 81, 82 aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder (the imaginary cylinder is taken as one that is disposed within the clamp receiving passageway 74, not coaxially aligned with the passageway 74, and at a proximal location from the steering tube 6) and a recess 87, 88 therein for the steering tube 6, each clamp member 81, 82 also having at least one fastener receiving passageway 85, 86 therein offset a predetermined distance from an axis defined by the imaginary cylinder in a direction away from the recess, and at least one fastener 84 extending between corresponding fastener receiving passageways 85, 86 of the pair of clamp members 81, 82 for urging the clamp members 81, 82 together to engage the steering tube 6 and thereby secure the bicycle stem to the steering tube;

wherein the recess 87, 88 for the steering tube 6 extends for greater than a predetermined angle;

wherein the pair of clamp members 81, 82 each have a same shape; and

further comprising a handlebar clamping member 32 cooperating with the handlebar clamping portion 31 to clamp the bicycle handlebar therebetween;

but fails to show the body portion, the handlebar clamping portion and the steering tube clamping portion being integrally formed as a monolithic unit and a plurality of fastener.

Roddy shows, in Figs. 2 and 4, a bicycle stem comprising a body portion 10, a handlebar clamping portion 13 and a steering tube clamping portion 14 being integrally formed as a monolithic unit, wherein the clamping portion 14 comprises a steering tube clamp 17, 18 aligned as a pair of cooperating clamp members in side-by-side relation and wherein a first bolt 21 and a second bolt 21 extend in opposite direction for urging the clamp members together to engage the steering tube 12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the multiple parts of Lai with the monolithic unit as taught by Roddy in order to provide a simpler method of making so that cost of making and installing is reduced.

As to the matter of the plurality of fasteners, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the single fastener of Lai with the plurality of fasteners as taught by Roddy in order to provide a tighter and more securing clamping device so that the operating the vehicle is safer.

#### ***Response to Arguments***

10. In response to the Applicant's argument that "there is provided clearance to permit the clamp portions to be positioned in the passageway as would be readily understood by those skilled in the art", it is the Examiner's position that the specification fails to describe in such a way as to enable one skilled in the art to understand fully how the clamp portions are "canted" in the passageway and that it would not be readily understood by those skilled in the art. The applicant has failed to explain in detail where such description is disclosed in the specification.

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Furthermore, the applicant has failed to explain how it would be readily understood by those skilled in the art.

11. In response to the Applicant's argument that the Double Patenting Rejection is improper, it is the Examiner's view that the Double Patenting Rejection is proper. A bicycle stem attached to a steering tube clamping portion as disclosed in the present invention is the same bicycle stem attached to a handlebar clamping portion as disclosed in 09/658,509 except that the attaching ends of the bicycle stems are reversed. Claiming that two portions are different because one is for attaching to a steering tube and the other is for attaching to a handlebar is not convincing. First of all, the recitation in the preamble of the claim preceding with the word "for" is for intended use and given no patentable weight. And second, both applications claim a bicycle stem. A bicycle stem is a bicycle stem whether it is intended to be attached to the steering tube or the handlebar.

12. In response to the Applicant's argument that Lai does not show the axis of the imaginary cylinder being offset from the axis of the passageway, it is the Examiner's contention that Lai does show such configuration. Claim 1 does not recite that the axis of the imaginary cylinder must be coaxial with the axis of the passageway. It simply recites "a pair of cooperating clamp members aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder" in lines 17-20. Since, it is the "imaginary" cylinder, the Examiner took the liberty to "imagine" that the imaginary cylinder is taken as one that is disposed within the clamp receiving passageway but not coaxially aligned with the axis of the passageway as described in paragraph 5 above.

13. In response to the Applicant's argument Roddy does not show the clamp receiving passageways and clamp portions therein for clamping to a steering tube as recited in claim 17, it is noted above in the rejection of claims 17, 18, 20-22, 24-27, and 29-31 that Lai comprises every element recited in the claims except the body portion, the handlebar clamping portion and the steering tube clamping portion being integrally formed as a monolithic unit and a plurality of fastener. Roddy is utilized to show that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the multiple parts of Lai with the monolithic unit as taught by Roddy in order to provide a simpler method of making so that cost of making and installing is reduced. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

14. In response to the Applicant's argument concerning the rejection of claim 24 over Lai in view of Roddy, the Examiner can not fully respond since the applicant fails to point out exactly where the test for obviousness failed.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CHK  
July 29, 2002



Chong H. Kim  
Primary Examiner  
Art Unit 3682